

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Andrew M. PERRY /

Serial No. 08/689,721 /

Examiner: R. Luebke

Filed: August 12, 1996

Group Art Unit: 2832

For: **DEVICE FOR SUSPENDING A RECORDER AND A METHOD FOR
USING THE SAME**

ATTENTION: Board of Patent Appeals and Interferences
Commissioner of Patents and Trademarks
Washington, D.C. 20231

2000 12 09 15
BOARD OF PATENT APPEALS
AND INTERFERENCES

REQUEST FOR REINSTATEMENT OF APPEAL

UNDER 37 C.F.R. §1.193(b)(2)(ii)

The Applicant filed a timely Notice of Appeal and a timely Appeal Brief in this case.

In lieu of an Examiner's Answer or Reply Brief, the Examiner mailed another Office Action on July 10, 2000. This is deemed to be reopening prosecution under 37 C.F.R. §1.193(b)(2). It is believed that such could render the Appeal moot.

The Applicant hereby requests Reinstatement of the Appeal, to the extent it is attempted to render it moot.

The Applicant submits herewith a Supplemental Appeal Brief under 37 C.F.R. §1.193(b)(2)(ii). This will prevent the Appeal from becoming moot. The Supplemental Appeal Brief is to be read as an adjunct to the Applicant's already submitted Appeal Brief. The Supplemental Appeal Brief addresses only the issues raised in the last Office Action, and contains no new amendments, affidavits or evidence.

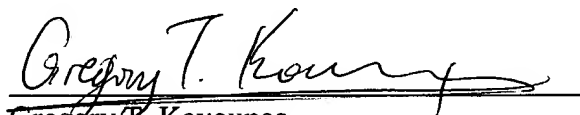
The status of the Applicant has not changed.

It is believed that no fee need to accompany this Request or the Supplemental Appeal Brief. If, however, such a fee is required, it may be charged to deposit account number 13-1703. A duplicate copy of this sheet is enclosed.

This Request and the Supplemental Appeal Brief are mailed within two months of the date of the last Office Action. Accordingly, no fee for extending time to respond is required. If, however, such a fee is required, it may be charged to deposit account number 13-1703. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

MARGER JOHNSON & McCOLLOM, P.C.

A handwritten signature in cursive script, reading "Gregory T. Kavounas", is written over a horizontal line.

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PATENT APPLICATION
Attorney's Do. No. 1981-1

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TRANSMITTAL LETTER

Assistant Commissioner for Patents
Attn: Board of Patent Appeals and Interferences
Washington, D.C. 20231

Enclosed for filing in the above-referenced application are the following:



Appellant's request for Reinstatement of Appeal (in Support of Appeal)
Appellant's Supplemental Brief (in Support of Appeal), in triplicate.

RECEIVED

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I hereby certify that this correspondence
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Postal Service as first class mail in an
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Commissioner for Patents, Washington,
D.C. 20231

Date: September 6, 2000

Corinne Ryan
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Respectfully submitted,

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APPELLANT'S SUPPLEMENTAL APPEAL BRIEF

UNDER 37 CFR §1.193(b)(2)(ii)

Appeal has been taken from the Examiner's Office Action mailed January 7, 2000,
finally rejecting claims 11-13 in the instant application.

In lieu of an Examiner's Answer or Reply Brief, the Examiner mailed another Office
Action on July 10, 2000. This is deemed to be reopening prosecution under 37 C.F.R.
§1.193(b)(2).

The Applicant has requested Reinstatement of the Appeal, and is submitting this
Supplemental Appeal Brief in furtherance thereof. This Supplemental Appeal Brief is
transmitted in triplicate. Each of the three copies is originally signed.

This Supplemental Appeal Brief is cross referenced, and is to be read in conjunction

with the Appeal Brief. It contains items under the same headings as the Brief. The Supplemental Appeal Brief addresses only the issues raised in the last Office Action, and contains no new amendments, affidavits or evidence.

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I. REAL PARTY IN INTEREST

37 CFR §1.192(c) (1)

Same as in the Appeal Brief.

II. RELATED APPEALS AND INTERFERENCES

37 CFR §1.192(c) (2)

Same as in the Appeal Brief.

III. STATUS OF CLAIMS

37 CFR §1.192(c) (3)

Same as in the Appeal Brief. (All claims 11-13 are still rejected, except under potentially different or additional grounds.)

IV. STATUS OF AMENDMENTS

37 CFR §1.192(c) (4)

Same as in the Appeal Brief.

V. SUMMARY OF THE INVENTION

37 CFR §1.192(c) (5)

Same as in the Appeal Brief.

VI. ISSUES ON APPEAL

37 CFR §1.192(c) (6)

Claims 11, 12 are now given three grounds for rejection, in paragraphs 3, 4 and 5 of the Office Action. (The fourth ground, paragraph 6 of the Office Action, pertains only to claim 13, is conceded, and not the subject of this Appeal.)

A new issue is raised by the rejection of paragraph 3. In addition, two rejections are given (paragraphs 4, 5), whose core issue however was briefed by the Applicant on appeal.

Possible Issue from Rejection #3: Is it proper to reject *claims* as new matter under 35 USC 132?

Possible Issue from Rejection #4: Does the original specification reasonably convey to one skilled in the relevant art that the ring be placed on the recorder after the strap is placed around the neck of the user?

Possible Issue from Rejection #5: Does the original specification enable to pull the recorder apart and then place the ring thereon *after* the strap is placed around the neck of the user?

The issues before the Board are thus:

* Issue 1: Is it proper to reject *claims* as new matter under 35 USC 132?; and

Issue 2: whether claims 11-12 are unpatentable under 35 U.S.C. § 112, first paragraph, as being based on a disclosure that allegedly does not provide enablement for a “certain method step” to be performed *after* another method step (of placing around the neck of the user).

* Issue 2A: the “certain step” is that the ring be placed on the recorder.

* Issue 2B: the “certain step” is pulling the recorder apart, and placing the ring on the recorder.

(Note that Issues 2A, 2B are very similar, if not identical, to what was briefed on appeal.)

VII. GROUPING OF CLAIMS

37 CFR §1.192(c) (7)

Claims 11 and 12 are independent claims. They are addressed to different patentable subject matter.

For purposes of this appeal, as to the appealed issues, claims 11 and 12 stand or fall together.

VIII. ARGUMENT

37 CFR §1.192(c) (8)

ISSUE 1

Is it proper to reject *claims* as new matter under 35 USC 132?

The Amendment filed on October 12, 1999 only introduces a new claim, namely claim 11. It does nothing else.

Yet the Office Action characterizes that amendment as introducing “new matter into the disclosure”, and bases a rejection on it. Such is in error. The M.P.E.P. states:

2163.06 I. If new subject matter is added to the disclosure, whether it be in the abstract, the specification, or the drawings, the Examiner should object to the introduction of new matter under 35 USC 132 ... If new matter is added to the *claims*, the Examiner should reject the claims under 35 USC 112, first paragraph – written description requirement. *In re Rasmussen*, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981). [Italics added.]

As such, the proper rejection to claim 11 would have been under 35 USC 112, first paragraph, not 35 USC 132 as was made.

Rejections under 35 USC 112, first paragraph, were indeed made, twice. (Issues 2A, 2B of this Supplemental Brief.) These are dealt with below. But the rejection of paragraph 3 of the Office Action can not stand, as it misapplies the M.P.E.P.

ISSUES 2A, 2B

For each of issues 2A, 2B the applicant repeats the argument made in the Appeal Brief. For reasons of economy, the Applicant is not repeating the verbiage, for each version of the “certain method step”. It is hoped that the Board will find it in accordance with the requirements of the M.P.E.P.

The Applicant requests that, in the Answer, the Examiner meet the burdens of making the rejections properly, as has been pointed out in the Brief. These include that the Examiner provide:

a) Statements of the type “What is missing for enablement is an order (or sequence) of performing these claimed steps.”, or “The sequence of the steps is needed to provide enablement because (with a purported reason).” M.P.E.P. Section 2164.06(a) requires both

types of such statements.

b) Of the three possible sequences with which the invention can be practiced (before, during and after placing the strap around the neck), an admission as to which of the three possible sequences she indeed regards as enabled. And if that is not the sequence that is actually claimed, why choose any one over the one sequence that is indeed claimed.

CONCLUSION

The Appellant requests favorable consideration by the Board. If any questions remain, please call the undersigned.

Respectfully submitted,
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